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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,071	06/15/2001	Jason G. Jarman	SIGS-1-1001	1725

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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/883,071	JARMAN ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23 and 28-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 28-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/2003, 10/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The amendment filed 4/3/03 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

For claim 5 (as amended in the preliminary amendment of 4/3/03), the specification as originally filed does not provide support for the limitation of "according to a rule". The examiner does not see where any kind of rule is disclosed (as originally filed) for the transposing or arranging of the recording as is claimed. This is considered to be new matter not supported by the originally filed specification.

For claim 8, the specification as originally filed does not provide support for the limitation of "flash memory card" and "hard drive". The specification as originally filed did not disclose either of these two storage mediums. The claimed "memory device on a server" is considered to be the disclosed "database" (see page 5). The examiner does not see where the flash memory and the hard drive have been disclosed. This is considered to be new matter not supported by the originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8,15-18,23,31, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, the claims do not require or recite the use of any technology, or anything that would be considered to be within the technological arts. The examiner notes that the claims recite a recording, but this is taken to just be the act of saving the song on a storage medium. This is taken to be nothing more than an insignificant post manipulative step that is insufficient to render the claims statutory. The claims do not use, apply, or advance the technological arts.

4. Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a "means for generating the personalized song according to the request", which includes people. Human beings are not allowed to be claimed as part of an invention in article claims. The specification discloses that musicians or artists are the ones that make the songs. The scope of claims 19-22 includes people, which renders the claims non-statutory.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5,8, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claim 5 (as amended in the preliminary amendment of 4/3/03), the specification as originally filed does not provide support for the limitation of "according to a rule". The examiner does not see where any kind of rule is disclosed (as originally filed) for the transposing or arranging of the recording as is claimed. This is considered to be new matter not supported by the originally filed specification.

For claim 8, the specification as originally filed does not provide support for the limitation of "flash memory card" and "hard drive". The specification as originally filed

did not disclose either of these two storage mediums. The claimed "memory device on a server" is considered to be the disclosed "database" (see page 5). The examiner does not see where the flash memory and the hard drive have been disclosed. This is considered to be new matter not supported by the originally filed specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5,16,19,23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 5, the scope of this claim is unknown, because it is not known what is meant by claiming that the transposing or arranging is done "according to a rule". What does this mean? The examiner also feels that this claim is indefinite because the specification discloses nothing about the rule so one wishing to avoid infringement would have no idea if they were infringing or not.

For claim 16, what is being claimed here? What is meant by reciting that the "point of view" is selected from the listed genres? What is meant by reciting that the "tempo" is selected from the listed genres? How can a tempo be "swing"? Correction is required.

For claim 19, the examiner is not clear as to what the scope of the term "means for making the stored songs available for purchase" is supposed to be. What does this refer to? The examiner is not clear as to what structural aspect of the invention

performs this function. Does this include advertising, that would alert people to the fact that songs are being sold? Clarification and correction is requested.

For claim 23, the claim recites "either to the designated recipient" but ends without clarifying another entity. The use of the term "either" sets forth that there is to be at least two options of whom the song is distributed to but only one is claimed. Correction is required.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1,3,6-8,9-14,19-22,28-30, are rejected under 35 U.S.C. 102(b) as being anticipated by "Song Legacy Custom Songs".

For claim 1,6-8, Song legacy discloses a company that makes customized songs for a requestor. The requestor can request a customized song for a birthday, anniversary, wedding, retirement, or any other function. The claimed providing a structure for a request is considered inherent because the "structure" for the request will inherently involve designating one of a genre, point of view, instrument choice, tempo, and recipient. A requestor requests a custom song, and Song legacy will then produce the custom song according to the request and product a CD recording of the song. The recording is then distributed to the recipient, who is the person receiving the recording.

For claim 3, the examiner considers Song legacy to anticipate what is claimed because the scope of the genres claimed cover every conceivable type of music. Any song would fall into one of the claimed categories because the categories themselves are very broad.

For claims 9-14,28-30, Song legacy inherently has a request acquisition center (the telephone and area where the phone is located for the taking of song requests via the telephone), a recording development center (the recording studio), a reproduction center (the digital computer recording technology), and a distribution center (an area where finished recordings are located and ready to be delivered). Song legacy performs all of the functions of receiving a song request, generating the song, recording the song on a storage medium, and distributing the song, so all of the structural "centers" claimed are found in Song legacy. For claim 11, the recording development center is fully capable of making more than one song as claimed. For claims 14,28 the songs are capable of being distributed over a network such as the postal service that mails packages. For claims 29,30, these claims do not recite any further structure to the system of claim 9, so Song Legacy anticipates what is claimed. Claims 29,30 are directed to the nature of the request and in article type of claims this defines no structure to the recited system.

For claims 19,21,22, Song legacy discloses a system as claimed. Song legacy discloses that requests can be sent by email or by phone. This satisfies the claimed "means for receiving a request" for a personalized song. The "means for generating the personalized songs" and the "means for transposing/arranging the personalized song"

are the Song legacy staff/employees that create the songs that are requested. The employees perform the function that has been claimed. The means for storing the original song and the transposed/arranged song are present in Song legacy because it is disclosed that songs are stored on disk. To store songs on disk you must have a means to store the song, such as hardware and software that allow the storage operation to occur. The database can be interpreted to be the CD's with stored songs.

For claim 20, the employees of Song legacy are fully capable of making songs with the claimed genre. In the system claims recitations directed to the song itself receive minimal patentable weight because the songs are not part of the system.

11. Claims 15-22, are rejected under 35 U.S.C. 102(b) as being anticipated by Clynes (5590282).

For claims 15-17,19-22, Clynes discloses a method of making personalized songs. Clynes discloses that 1st original songs are stored in a database. The 1st original songs have inherently been generated as claimed and are original. Clynes discloses that a person can specify various parameters of the original song to create a customized 2nd song. See column 5, where the many features that one can specify and customize about a song (includes tempo and musical instrument) to create a 2nd customized song are disclosed. Column 6, lines 1-6 disclose that the 2nd customized song can be saved in the database of the central computer 10. The stored songs are made available for purchase as claimed because column 5, lines 7-9 disclose a fee that the user must pay to use the system. The 1st stored songs are available for purchase

as claimed. Clynes discloses all of the recite functions specified in the means plus function language of claims 19-22, so Clynes also discloses "a means" for doing what is claimed.

For claim 18,22, the songs in Clynes are offered for sale and are delivered as claimed. With respect to the recitation of offering the songs for sale and delivery with an announcement, this is interpreted to be any manner of notifying the requester that the song has been delivered. The claimed "announcement" is taken to be the notification to the requester that the song has been received. The examiner considers the "announcement" to be inherent when a person is receiving a song.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 2,4,5,23,31, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Song Legacy Custom Songs".

For claim 2, not disclosed is that the request is for a plurality of genres, tempos, etc.. The examiner interprets this to be the requesting of more than one song, because each song will have a different tempo or genre or even point of view. No two songs are the same and any two songs will satisfy what is claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to receive a request for more than one song. Song legacy discloses that they can capture "the life story of the guest of honor on a personalized music CD". In view of this it would have been obvious to one of ordinary skill in the art that to capture the life story of the guest of honor, you would need more than one song. Claim 2 is just reciting the requesting of more than one song, which is obvious.

For claim 4, not disclosed is that the generating the song includes the arranging of a second requested song based on a first song that differs in the point of view. Song legacy discloses that a custom birthday song can be produced. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a "Happy Birthday" custom song by using the name of the person having the birthday in the custom song itself. The second song is the customized birthday song that is based on a first generic birthday song that is just missing the name of the person having the birthday.

For claim 5, the claimed "rule" is interpreted to the place in the song where the name of the birthday person is supposed to go. The name needs to be placed at the

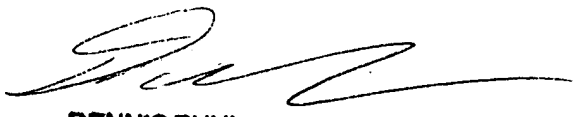
correct place in the song so the song makes sense, and the examiner interprets this to be a rule.

For claims 23,31, Song legacy discloses the claimed steps of receiving a request for a song, generating a song, and storing the song on a storage medium. Not disclosed is the arranging of the song by changing one of genre, point of view, instrument choice, or tempo and then recording and distributing the songs to the recipient. It is a well known fact that songwriters and musicians spend a great deal of time writing music and fine tuning a song. Many tracks are made during the recording process and many changes are commonly made during this process. The generation of a final version of a song does not happen the first time it is recorded, experimentation and fine tuning is necessarily involved. It would have been obvious to one of ordinary skill in the art at the time the invention was made to alter an original first recording of a song by changing the tempo or the genre during the recording process in an attempt to make the best song possible. With respect to the distributing of the songs to the recipient, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give the recipient more than one version of the song to see which one they like best or to get further guidance from the customer on what direction they would like to go with the song.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER